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EXAMINER

WONG, STEVEN B

ART UNIT

PAPER NUMBER

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Please find below and/or attached an Office communication concerning this application or proceeding.



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**BEFORE THE BOARD OF PATENT APPEALS
AND INTERFERENCES**

Paper No. 8

Application Number: 09/837,824
Filing Date: April 18, 2001
Appellant(s): DAVIS, GLEN

Douglas McEvoy
For Appellant

EXAMINER'S ANSWER

This is in response to the appeal brief filed November 12, 2002.

(1) *Real Party in Interest*

A statement identifying the real party in interest is contained in the brief.

(2) *Related Appeals and Interferences*

A statement identifying the related appeals and interferences which will directly affect or be directly affected by or have a bearing on the decision in the pending appeal is contained in the brief.

(3) *Status of Claims*

The statement of the status of the claims contained in the brief is correct.

(4) *Status of Amendments After Final*

The appellant's statement of the status of amendments after final rejection contained in the brief is correct.

(5) *Summary of Invention*

The summary of invention contained in the brief is correct.

(6) *Issues*

The appellant's statement of the issues in the brief is correct.

(7) *Grouping of Claims*

Appellant's brief includes a statement that claims 1-3 and 4-10 do not stand or fall together and provides reasons as set forth in 37 CFR 1.192(c)(7) and (c)(8).

(8) *Claims Appealed*

The copy of the appealed claims contained in the Appendix to the brief is correct.

(9) *Prior Art of Record*

3,544,113	Hand	12-1970
4,151,997	Glovak et al.	05-1979

(10) Grounds of Rejection

The following ground(s) of rejection are applicable to the appealed claims:

Claim 1 is rejected under 35 U.S.C. 102(b) as being anticipated by Hand. Regarding claim 1, Hand discloses a set of water skipping articles comprising a three dimensional body (45) defined by upper and lower elliptically extending faces (41, 42) and a hollow interior cavity (57). The interior cavity is formed by elliptical surfaces (49, 55).

Claims 3, 5-8 and 10 are rejected under 35 U.S.C. 103(a) as being unpatentable over Hand. It would have been obvious to one of ordinary skill in the art to form the width to form the skipping article of Hand with the instantly claimed dimensions as the appellant has not shown the criticality by a new and unexpected result and it appears that the dimensions shown by Hand would accomplish similar purposes.

Claims 2 and 9 are rejected under 35 U.S.C. 103(a) as being unpatentable over Hand in view of Glovak et al. (4,151,997). Glovak et al. reveal a water skipping article formed from sand and a water soluble organic binder (column 1, lines 33-43). It would have been obvious to one of ordinary skill in the art to form the article of Hand from the materials of Glovak et al. in order to provide an environmentally friendly water skipping article.

(11) Response to Argument

Regarding the appellant's argument that the surfaces of Hand are not elliptical in shape, it appears that appellant is using his own definition of the terminology. Attention is directed to the definition cited from Webster's Ninth New Collegiate Dictionary attached to the Final Rejection which stated that an "ellipse" is defined as oval in shape and "elliptical" is defined as "of, relating to, or shaped like an ellipse". Clearly, Figures 2 and 5 of Hand show the water skipping

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article having surfaces with an oval cross section and being shaped like an ellipse. Although Hand does not particularly state that the surfaces are elliptical, it does not preclude one of ordinary skill in the art from discerning from the Figures that the water skipping article is elliptical in cross section.

Regarding the enhanced performance characteristics obtained by the water skipping device of the present invention, the appellant had been invited to provide evidence of a new and unexpected result obtained from the particularly claimed dimensions. Lacking any evidentiary showing of a new and unexpected result obtained from the claimed dimensions, the claimed dimension have been determined to be obvious over the teachings of Hand. See *In re Aller et al.*, 105 USPQ 233.

Regarding the appellant's statement that Hand provides a pointed outer edge and not the claimed smooth edged outer perimeter, the appellant appears to be arguing a difference in degree that is not presented in the claims. While the rounded edge (45) of Hand might not be to the same degree as that of appellant's, the instant claims do not particularly define this degree and thus, the water skipping article anticipates the claimed limitation.

Attention is directed to pages 6 and 8 of the instant specification. While page 6, lines 15-18 states that the embodiment of Figure 1 shows a perfect ellipse for the water skipping article, page 8 clearly states that invention is not limited to any set ratio of width to thickness. Indeed, lines 7-10 of page 8 note that other ratios may be incorporated with the present invention. Thus, it is clear that although claim 1 recites an elliptical shape for the instant invention, the specification does not provide any support for the criticality of the claimed invention to be a perfect ellipse as would be defined by the mathematical equation. The instant specification

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suggests that other shapes for the outer perimeter may be utilized and still achieve the gyroscopic or self-correcting flight effect.

Regarding the appellant's argument that Hand does not mention any gyroscopic or self-correcting flight effects, the instant claims fail to recite these effects. Although the claims are interpreted in light of the specification, limitations from the specification are not read into the claims. See *In re Van Geuns*, 988 F.2d 1181, 26 USPQ2d 1057 (Fed. Cir. 1993).

Regarding the appellant's statement that the gyroscopic effects provides a new and unexpected result, the statement does not demonstrate any evidence that the dimensions recited by appellant provide a new and unexpected result and it would appear that the dimensions and shape as taught by Hand would accomplish similar purposes.

Regarding claims 3, 5, 6 and 8, again the appellant fails to present any criticality for the claimed dimensions by a showing of a new and unexpected result and it would appear that the shape and dimensions taught by Hand would accomplish similar purposes. The appellant had been invited to submit evidence supporting the criticality of the dimensions, however, he has failed to do so.

Regarding the limitation for the article to be formed from a biodegradable material, attention is directed to the rejections of claims 2 and 9 wherein the reference to Glovak et al. teaches a water skipping article formed from a biodegradable material. The reference to Glovak et al. is relied upon merely for its teaching that it is well known in the art of water skipping articles to form them from a biodegradable material. The reference to Hand is still relied upon for teaching the claimed elliptical shapes.

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In response to appellant's argument that there is no suggestion to combine the references, the examiner recognizes that obviousness can only be established by combining or modifying the teachings of the prior art to produce the claimed invention where there is some teaching, suggestion, or motivation to do so found either in the references themselves or in the knowledge generally available to one of ordinary skill in the art. See *In re Fine*, 837 F.2d 1071, 5 USPQ2d 1596 (Fed. Cir. 1988) and *In re Jones*, 958 F.2d 347, 21 USPQ2d 1941 (Fed. Cir. 1992). In this case, Glovak et al. particularly teach forming the water skipping article from a biodegradable material for water ecology purposes. It would have been obvious to one of ordinary skill in the art to form the water skipping article of Hand from the biodegradable material taught by Glovak et al. for water ecology purposes.

Regarding the arguments of claim 10, again the appellant had been invited to demonstrate the criticality for the claimed difference in width to thickness ratio between the first and second ellipses. Lacking any evidentiary showing by a new and unexpected result, the differences in elliptical ratios between the teachings of Hand and that instantly claimed are determined to be obvious and an unpatentable modification. See *In re Aller et al.*, 105 USPQ 233.


Attention is directed to page 7, lines 19-23 of the instant specification suggesting that the elliptical interior cavity is not critical. The lines particularly note that the specific and radial configuration may be modified such as by widening or narrowing the edge. Thus, it is clear that the invention is in no way limited to the shape shown by Figure 3 and in fact elliptical shapes as taught by Hand would render the limitation obvious.

For the above reasons, it is believed that the rejections should be sustained.

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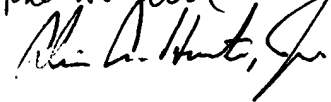
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Respectfully submitted,


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SBW
January 24, 2003

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